

REMARKS

A. Introduction

Claims 1, 3-9, 21, and 24-33 were pending and under consideration in the application, Claims 2, 10-20, and 22-23 having been previously canceled.

In the Office Action dated October 19, 2011, claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-9, 21, and 24-33 were rejected under 35 U.S. C. §103(a) as allegedly being unpatentable over Boushy, et al., U.S. Patent No. 6,003,013 (hereinafter, Boushy) in view of Pierce, U.S. PatentNo. 6,332,126 (hereinafter, "Pierce") and Walker, U.S. Patent Publication No. 2003/0027635 (hereinafter, "Walker").

Alternatively, claims 1, 3-9, 21, and 24-33 were rejected under 35 U.S. C. §103(a) as allegedly being unpatentable over Walker in view of Pierce and Boushy.

In response Applicants are hereby amending the claims for clarity and to obviate the grounds for the 35 U.S.C. §112, second paragraph, rejection.

No new matter is being added.

B. Rejections under 35 U.S.C. §112, second paragraph

Claims 1-9 were rejected, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The grounds for the rejection having been obviated by the instant amendment, withdrawal of the rejection is respectfully requested.

C. Rejections under 35 U.S.C. §103

Claims 1, 3-9, 21, and 24-33 were rejected as allegedly being unpatentable over Boushy in view of Pierce and Walker.

Alternatively, claims 1, 3-9, 21, and 24-33 were rejected as allegedly being unpatentable over Walker in view of Pierce and Boushy.

Walker relates to techniques for determining a recipient of an offer; and for determining an offer which includes an activity and a benefit. The techniques further provide for transmitting, to a representative, instructions to provide the offer to the recipient and determining whether the recipient has performed the activity, and if so providing the benefit to the recipient. Walker, abstract.

As acknowledged by the Office Action (page 22) Walker does not disclose determining for each of the awards a respective likelihood of acceptance and sorting the two or more awards according to the respective likelihood of acceptance.

Likewise, Walker fails to disclose, as claimed, ***determining, at the central server, in substantially real time***, a recommendation of at least one award to offer to the first patron by ***receiving an input from the system user, via the display device***, of at least one of a first patron profile definition and an award type; assigning, ***responsive to the input from the system user***, a profile for said first patron, and determining for each of the awards a respective likelihood of acceptance by said first patron based upon the historical transaction information and the observed preference data; and sorting the two or more awards according to the respective likelihoods of acceptance.

Pierce fails to cure the above mentioned deficiencies.

Pierce discloses techniques for operating a computer based targeted payment system discount program. Consumer information from consumer payment system institutions is used to match qualified consumers to targeted merchant discount offers. Offers are automatically prioritized based on their expected value to consumers and consumers receive the highest priority offers for which they qualify. The default prioritization can be altered or overridden by the consumer's payment systems institution. Discounts are automatically applied during the processing of the qualifying purchase without the need for coupons or additional actions by either the merchant or consumer. Pierce, abstract.

The Office Action (page 22) asserted that Pierce discloses consumer transaction histories used to match qualified consumers to targeted merchant discount offers, where offers are

automatically prioritized based on their expected value to consumers and consumers receive the highest priority offers. Whether or not the assertion is true, and assuming, arguendo, that Pierce could be properly combined with Walker, such disclosure fails to cure the deficiencies noted above, at least because the techniques disclosed in Pierce are not operable in substantially real time, and are not responsive to an input received from a system user via a display device.

Moreover, even if Pierce disclosed the subject matter acknowledged to be absent in Walker, the Office Action's 103(a) rejection is still flawed, because, except based on improper hindsight reasoning, one of skill in the art would not have been motivated to combine Walker and Pierce. See: KSR International Co. v. Teleflex, 550 U.S. 398 at 418 (2007)) ("A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.") The Office Action is flawed at least because it fails to articulate how or why Walker and Pierce would be combined to yield the claimed invention. See Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008) "We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention."

As evidence, Applicants note that the stated goal of Pierce is

"to provide merchants with a flexible, cost effective method to provide a large number of interested consumers with value propositions that discount the merchants products and services, and to provide consumers, or cardholders, with a broad range of merchant offers in which they will be most interested. A further goal and effect of the invention will be to increase the use of the bankcards of participating financial institutions, which provides a convenient automated means for implementing targeted discounts without the need for coupons, mailings, or additional transactions on the part of either the cardholder or merchant. Finally, the invention meets the above objectives while at the same time preserving the consumers' privacy by avoiding the dissemination of the cardholders' transaction histories to merchants or outside financial institutions. Pierce, 2:15-33.

To meet these objectives Pierce:

"utilizes five basic steps: (1) an automated process which enables the merchant to target consumers based on purchase behavior and geographic location; (2) an automated process which matches targeted merchant offers against a data base of consumers and historical purchase behavior; (3) an automated process which provides the consumer with the best value propositions from multiple

merchants/service providers; (4) the ability for the consumer to act on the value proposition and receive an automated credit for the discount amount without the need of a coupon or additional transactions; (5) an automated process which reports on the execution of the discount transaction to the consumer and merchant.” Pierce, 2:34-46.

In distinct contrast, Walker is directed toward enabling

“an employee of a casino or other business (the employee referred to as a "representative") to work with a computer system to determine an offer and present it to a recipient, such as a player at a gaming device. For example, a representative on the floor of a casino may carry a PDA (personal digital assistant) or other device, such as a cellular telephone or other wireless electronic device. Using the PDA, the representative may identify players who should receive offers.” Walker, paragraph 0020.

Put shortly, Pierce relates to an automated provision, by a third party bank card issuer or financial institution, to consumers, of merchants’ offers and discounts while avoiding the dissemination of the cardholders' transaction histories to merchants, whereas Walker relates to improving the efficiency of a human representative of a casino or other business in making offers directly, on behalf of the casino or other business, to a player at a gaming device.

Accordingly, Walker and Pierce are intended to solve entirely different kinds of problems. The combination, therefore, could only result from the use of improper hindsight reasoning in view of the present application. See also: Ex parte Young, (Appeal 2010010001; Appl. No. 12/103,325 [March 29, 2011] at p. 4, ¶ 1.) where the Board of Patent Appeals and Interferences reversed an Examiner’s obviousness rejection when the primary reference involved solutions to one problem and the secondary reference involved solutions to another problem.

As a result, claims 1 and 21, and claims depending therefrom are patentable over the combination of Walker and Pierce.

The Office Action asserted that Boushy discloses generating and receiving a script containing information relating to conveyance of awards. Whether or not the assertion is true, such disclosure fails to cure the deficiencies noted in above.

As a result claims 1 and 21, and claims depending therefrom, are patentable over the combination of Walker, Pierce, and Boushy.

D. Conclusion

The claims are believed to be in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorneys at (510) 663-1100.

Applicants do not believe that any additional fees are required to facilitate the filing of this Amendment. However, if it is determined that such fees are due, please charge such additional fees to Deposit Account No. 504480 (Order No. IGT1P419BX1).

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